

**REMARKS**

Entry of the foregoing and further and favorable reconsideration of the instant application, pursuant to and consistent with 37 C.F.R. §§ 1.111, are respectfully requested.

**Status**

Claims 1-30 are pending in this application. *Office Action mailed April 5, 2006, Office Action Summary, Item 4.* Claims 1, 3-6, and 10-12 stand rejected. *Id. at Item 6.* Claims 2, 7, 8, and 13-30 are objected to. *Id. at Item 7.*

Original Claims 1-30 were subject to an election of species requirement. *Office Action mailed November 14, 2005, Page 2.* According to the Examiner, the application contained "claims directed to the following patentably distinct species of the claimed invention: 1) indicia printed on the surface and 2) indicia embedded in the cover." *Id.* In response to that requirement, Applicants elected species (1), indicia printed on the surface. *Election filed January 10, 2006.*

**Information Disclosure Statement**

Applicants hereby file with this Amendment and Response a First Information Disclosure Statement ("First IDS") and corresponding Form PTO-1449. The items listed in this First IDS are also listed in the text of the Specification.

Applicants respectfully request that the Examiner return an Examiner-initialed copy of the Form PTO-1449 for the First IDS.

**Summary of Amendments**

By the foregoing amendments, Applicants have amended Claim 28 to correct the spelling of “polysaccharides.” This amendment is clerical in nature. However, support for this amendment may be found at least at Page 19, Line 18 of the Specification and in original Claim 28. Accordingly, no new matter has been added.

**Allowable Subject Matter**

Applicants note with appreciation that the Examiner has indicated that “Claims 2, 7-8, and 13-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.” *Office Action mailed April 5, 2006, Page 2, Last Paragraph.*

**Rejections Under 35 U.S.C. § 102(e)**

Claims 1, 3-6, and 10-12 were rejected under 35 U.S.C. § 102(e) as purportedly anticipated by U.S. Patent Application Publication 2003/0114254 to Emalfarb (“Emalfarb”).<sup>1</sup> *Office Action mailed April 5, 2006, Page 2, Middle Paragraph.* According to the Examiner, “Emalfarb discloses a golf ball comprising an outer layer (applicant’s masking layer) that degrades when exposed to water. The layers inherently have a predetermined color and are opaque.” *Id.* This rejection is respectfully traversed.

“Invalidity based on ‘anticipation’ requires that the invention is not in fact new.” *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1120 (Fed. Cir. 2002) (quoting *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302 (Fed. Cir. 1995)). “A single

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<sup>1</sup> Applicants draw the Examiner’s attention to the fact that Emalfarb issued as U.S. Patent No. 7,056,230 on June 6, 2006.

reference must describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art.” *Verve*, 311 F.3d at 1120 (citing *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990)). Put differently, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Applicants respectfully submit that Emalfarb fails to disclose each and every element of Claims 1, 3-6, and 10-12. For example, Claim 1 is a method claim. Claim 1 is a method for providing a golf ball with an indication that its physical properties have been degraded due to the presence of water in the golf ball. The method of Claim 1 comprises:

(1) providing a surface of a golf ball that indicates that the ball has been subjected to water for a time that affects the physical properties of the golf ball, and (2) covering the surface with a water-activated masking layer that is altered to permit viewing of the covered surface upon being subjected to water. This outer layer is termed an “opacification layer” in the application. “Under normal conditions the opacification layer blocks the view of the underlying surface. When the opacification layer is water-activated it becomes transparent or is removed, thus unmasking the underlying layer carrying the water immersion-indicating surface or indicia.” *Page 5, Lines 1-6 of the Specification*. “Depending on the type of physical operation involved, immersion of the golf ball for a sufficiently long period of time causes the opacification layer to either be rendered transparent, to be removed, or to reduce its light-blocking characteristics.” *Id. at Page 5, Lines 7-9.*

Contrarily, Emalfarb is directed not to a method, but to golf balls themselves. The golf balls of Emalfarb have a “first performance characteristic” which “upon being immersed in water continuously for a time period less than one hundred eighty days so that the golf ball

has a second performance characteristic that is different than the first performance characteristic." See, e.g., *Emalfarb*, ¶ 0008. In some of the golf balls of Emalfarb, a portion of the cover layer of the golf ball has a material that will change shape, size and hardness as an incident of being immersed in water. *Emalfarb*, ¶¶ 0045-0048. "The change may be such that the material flakes, chips, cracks, dissolves, or otherwise degrades or loses durability in a manner that the performance characteristics of the golf ball are noticeably altered."

*Emalfarb*, ¶ 0048. The material that changes shape, size and hardness may also be the entire cover layer or may be the entire ball. *Emalfarb*, ¶¶ 0056, 0058.

Emalfarb fails to disclose each and every element of Claims 1, 3-6, and 10-12. It is not enough that Emalfarb merely discloses a "golf ball comprising an outer layer (applicant's masking layer) that degrades when exposed to water." Emalfarb lacks at least the elements of Claims 1, 3-6, and 10-12 where: (a) a golf ball has a surface that indicates that the ball has been subjected to water for a time that affects the physical properties of the golf ball, *and* (b) that surface is covered with a water-activated masking layer. At best, Emalfarb discloses something that *could* be used as element (b), the water-activated masking layer. Emalfarb is silent with respect to element (a), a golf ball with a surface that indicates the ball has been subjected to water. Emalfarb is also silent with regard to Applicants' golf balls with *both* element (a) and element (b), *i.e.*, Applicants' golf ball construction is not disclosed in Emalfarb.

Because each and every element of Claims 1, 3-6, and 10-12 are not disclosed in Emalfarb, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(e) rejection thereof.

**CONCLUSION**

It is respectfully submitted that all rejections have been overcome by the above amendments and remarks. Thus, a Notice of Allowance is respectfully requested.

In the event that there are any questions relating to this Amendment and Response Under 37 C.F.R. § 1.111, or to the application in general, it would be appreciated if the Examiner would contact Applicants' undersigned attorney by telephone at (202) 373-6000 so that prosecution of the application may be expedited.

The Director is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-2518.

Respectfully submitted,  
BINGHAM McCUTCHEN, LLP

Date: September 5, 2006

By:



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